

REMARKS/ARGUMENTS

Claims 1-8 are pending. Claims 1, 3, 5, 6, and 8 are amended.

The objection to claims 3-8 based on 37 CFR 1.75(c) and the rejections of the claims under Section 112 are believed to be obviated by the foregoing amendments.

The claims stand rejected based on the prior art as follows:

Claims	Rejection
1	35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,470,302 to Cunningham et al.
2	35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,470,302 to Cunningham et al. in view of U.S. Patent No. 6,929,481 to Alexander et al.

All rejections are respectfully traversed.

Turning to the rejection of claim 1 under Section 102, it is well settled that the burden of establishing a prima facie case of anticipation under Section 102 resides with the United States Patent and Trademark Office. See, In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

To meet this burden of establishing a prima facie case of anticipation, the Examiner must explain how the rejected claims are anticipated by pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection. In this case, the Examiner has not pointed out where all of

the limitations of independent claim 1 are found in the cited Cunningham patent.

Claim 1, as amended, requires that the dummy instrument have **a control body with a user manipulatable angulation controller, an insertion tube**, and an umbilical extending from the control body. The angulation cable extends from the user manipulatable angulation controller, and down the umbilical to **a device for controlling the resistance to movement of the cable to provide force feedback simulating a force at the controller**.

The Examiner asserts that the Cunningham '302 patent discloses in Fig. 5B and the Specification, a dummy medical instrument comprising a **control body 89 with user manipulatable angulation control**, and an angulation cable 49 which extends through an umbilical 72 to **a device which controls the resistance to movement to provide force feedback during use**.

The highlighted portions represent claim limitations for which the Examiner has not sufficiently identified corresponding structure in the prior art.

For example, the Examiner asserts that reference numeral "89" corresponds to the claimed control body. However, with reference to Fig. 5B and the Cunningham patent, it is noted that the structure corresponding to reference numeral 89 is encoder assembly 89. It is respectfully submitted that the encoder assembly does not fairly correspond to the claimed control body.

It is further noted that the Examiner has not pointed out any structure associated with the encoder assembly 89 (or the enclosure adjacent the reference numeral 89, which appears to be shaft 44) alleged to correspond to the claimed "user manipulatable angulation controller." The structure associated with the "control body" shown in Fig. 5B is an encoder assembly 89, an encoder assembly 87, shaft 72, wire 49, and a catheter hub 46. No "user manipulatable angulation controller" as required by the claims has been identified by the Examiner.

Claim 1 also requires an insertion tube, and the Examiner has not identified any structure in the cited Cunningham patent alleged to correspond to the claimed insertion tube.

The Examiner has also failed to identify the structure in the Cunningham patent alleged to correspond to the claimed force feedback device.

Thus, in failing to specifically point out where all of the limitations are found in the prior art, the Examiner has not met the burden of establishing a prima facie case of anticipation.

The rejection is further flawed in that the structure of the Cunningham device does not provide, as required by claim 1, “an angulation cable extending from the user manipulatable angulation controller, and down the umbilical to a device for controlling the resistance to movement of the cable to provide force feedback simulating a force at the controller.”

The Examiner asserts that the claimed angulation cable is provided by wire 49, that the claimed umbilical is provided by the needle shaft 72, and that the angulation cable 49 extends through an umbilical 72 to a device which controls the resistance to movement to provide force feedback during use.”

As noted, there is no structure of the control body identified by the Examiner as providing the angulation controller. Moreover, it is submitted that the control body has no such structure and the rejection is unsustainable for this reason alone, since claim 1 requires that the control body have an angulation controller.

In addition, it is submitted that the wire 49 does not extend from an angulation controller. The wire also does not extend down an umbilical to a device for controlling the resistance to movement of the cable to provide force feedback simulating a force at the controller.

While the Examiner has not identified any “force feedback” structure, it is observed that the Cunningham patent describes a force feedback unit 54 coupled to the shaft 44 to impede motion of the shaft 44. See, Col. 10. However, this does not provide the claimed structure

and the wire 49 does not extend from an angulation controller, down the umbilical (needle shaft 72) to a device for controlling the resistance to movement of the cable to provide force feedback simulating a force at the controller.

Accordingly, withdrawal of the rejection under Section 102 is requested. Likewise, for these same reasons, withdrawal of the rejection under Section 103 based on the asserted Cunningham patent is respectfully requested.

Reconsideration and issuance of a notice of allowance is requested. In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

Respectfully submitted,

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